



5-19-00

Our Ref. No.: 060850.P002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Michael J. Thermos

Serial No.: 08/975,284

Filed: November 20, 1997

For: NOZZLE

Examiner: Kevin Weldon

Art Unit: 1734

#14 Reply
Brief

REPLY BRIEF

Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

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I. NEW ISSUES RAISED BY THE EXAMINER'S ANSWER RELATED TO THE REJECTION BASED ON STATEMENTS OF INTENDED USE

Examiner has taken the position that recitations in claim 1 "for providing a nitrous oxide/fuel mixture to a combustion cylinder" and "a body member used in combination with a combustion engine" do not provide further limitation and that they are merely statements of intended use.

Specifically, Examiner has indicated that he does not consider the combustion engine to be positively recited in the claim body language "a body member used in combination with a combustion engine." In this regard, applicant respectfully submits that the limitation in the claim body is positively recited by the use of language "used in combination with." As a general rule, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. While certain terms (e.g., "for use with") may raise a question as to the

limiting effect of the language in a claim, language such as "used in combination with" generally has the effect of providing limitation. Here, the claim is explicitly limited to the combination of the combustion engine and the nozzle.

In addition, the language in the preamble further limits the claim if such is "necessary to give meaning to the claim[s] and properly define the invention." In re Fritch, 972 F.2d 1260, 1262, 23 USPQ2d 1780, 1781 (Fed. Cir. 1992). Language appearing in the preamble limits the claim where "that language is essential to particularly point out the invention defined by the claims." Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 866, 228 USPQ 90, 92 (Fed. Cir. 1985) (term appearing in preamble is a "necessary limitation" where the term "breathes life and meaning into the claims.").

The specification of the present application makes clear that Applicant was working on the particular problem of creating an aerosol of fuel-nitrous oxide mixture to allow for an efficient combustion in a combustion chamber to run the engine, and not on general torch devices. In view of the specification, it is apparent that Applicant intended claim 1 to encompass only a nozzle that possesses certain physical characteristics necessary to be used with a combustion engine. Thus, the preamble language "a nozzle for providing a nitrous oxide/ fuel mixture to a combustion cylinder" and the language of the claim body "used in combination with a combustion engine" do give "life and meaning," and thereby provides further limitations that must be disclosed in the prior art for the claims to be anticipated.

However, even if one were to accept that such languages of claim 1 are characterized as statements of intended use, *arguendo*, intended use recitations and other types of functional language cannot be entirely disregarded. If the prior art structure is incapable of performing the intended use, then it does not meet the claim. The nozzle claimed in claim 1 includes a body member which is capable of being used with a combustion engine to provide a nitrous oxide/fuel mixture thereto. Whereas, the cited references, Rodrigues-Ely and Yerkins, do not disclose or suggest such body member which is capable of being attached to a combustion engine such that it can deliver a mixture of fuel and oxygen from its outlet end into

the combustion chamber. Therefore, the torch tips in Rodrigues-Ely and Yerkins are incapable of performing the intended use of the present invention.

In conclusion, the preamble language of Claim 1, "a nozzle for providing a nitrous oxide/fuel mixture to a combustion cylinder" and the language of the claim body "used in combination with a combustion engine" do give "life and meaning," and thereby provide further limitations that must be disclosed in the prior art for Claim 1 to be anticipated.

II. NEW ISSUES RAISED BY THE EXAMINER'S ANSWER RELATED TO THE REJECTION BASED ON INHERENCY

"To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently." In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). Examiner has indicated that "although the nozzles in both Rodrigues-Ely and Yerkins do not expressly disclose all of these functional limitations the passages in Rodrigues-Ely and Yerkins are inherently capable of supplying nitrous/oxide and liquid fuel therethrough."

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Continental Can Co. v. Monsanto Co., 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." Id. At 1269.

In finding anticipation by inherency, Examiner has indicated that "if nitrous oxide and liquid fuel are supplied to the first and second channels in Rodrigues-Ely and Yerkins nitrous oxide emerging from the second tube outlet would expand radially as it exited the outlet end of the tube atomizing the surrounding concentric fuel streams." In doing so, Examiner has made no attempt to show that the torch tips of Rodrigues-Ely and Yerkins used to perforate and cut metals are suitable for

attachment to a combustion engine and injecting a mixture of nitrous oxide and fuel into a combustion chamber in a form that allow for an efficient combustion in an internal combustion engine.

As mentioned above, inherency may not be established by probability or possibilities. However, the examiner's inherency analysis rests only upon unsupported conjecture that does not rise even to the level of probability or possibility that the torch tips described in Rodrigues-Ely and Yerkins are capable of delivering a suitable aerosol of fuel-nitrous oxide mixture to allow for an efficient combustion in a combustion engine. Therefore, Examiner's theory that torch tips in Rodrigues-Ely and Yerkins are capable of performing the same functions as a nozzle for providing a nitrous oxide/fuel mixture to a combustion cylinder in claim 1 is insufficient to show that the claimed device is inherent in Rodrigues-Ely and Yerkins.

In this connection it is noted that the torch tips provide no facility for attachment and sealing with a combustion cylinder, absent such sealing one of ordinary skill in the art would clearly recognize that the engine would not function. Thus the examiner's disfunctional creation cannot anticipate applicant's claimed invention through inherency or otherwise.

In conclusion, it is respectfully submitted that anticipation by inherency cannot be established since torch tips in Rodrigues-Ely and Yerkins are incapable of performing the claimed functionality including: providing a nitrous oxide/fuel mixture to a combustion cylinder as claimed in Claim 1.

IV. CONCLUSION

Based on the foregoing, Applicants request that the Board overturn the rejection of all pending claims and hold that all of the claims of the present application are allowable.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

Dated: 5/9/00

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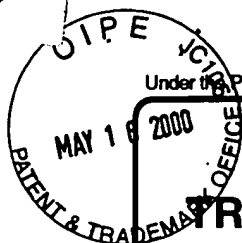
GPI 1734

PTO/SB/21(10/96)

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)		Application Number	08/975,284
		Filing Date	November 20, 1997
		First Named Inventor	MICHAEL J. THERMOS
		Group Art Unit	1734
		Examiner Name	WELDON, K.
Total Number of Pages in This Submission	9	Attorney Docket Number	060850.P002

ENCLOSURES (check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> To Convert a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): <div style="border: 1px solid black; padding: 5px; margin-top: 10px;"> REPLY BRIEF (5) POST CARD (1) </div>
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Thomas M. Coester, Reg. No. 39,637 BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN
Signature	<i>Thomas Coester</i>
Date	May 9, 2000

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: May 9, 2000

Typed or printed name	Marsha M. Sweet		
Signature	<i>Marsha M. Sweet</i>	Date	05/09/00

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FEE TRANSMITTAL

Patent fees are subject to annual revision on October 1.
These are the fees effective October 1, 1997.
Small Entity payments must be supported by a small entity statement.
Otherwise large entity fees must be paid. See Forms PTO/SB/09-12.
See 37 C.F.R. §§ 1.28 and 1.28

TOTAL AMOUNT OF PAYMENT (\$)

Complete if Known

Application Number	08/975,284
Filing Date	11/20/97
First Named Inventor	MICHAEL J. THERMOS
Examiner Name	WELDON, K.
Group Art Unit	1734
Attorney Docket Number	060850.P002

METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:

Deposit Account Number 02-2666
Deposit Account Name Blakely, Sokoloff, Taylor & Zafman LLP

- ☒ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17 ☐ Charge the Issue Fee Set in 37 CFR 1.18 at the Mailing of the Notice of Allowance, 37 CFR 1.311(b)

2. ☐ Payment Enclosed:
☐ Check ☐ Money Order ☐ Other

FEE CALCULATION (fees effective 10/01/96)

1. FILING FEE

Large Entity Code	Large Entity Fee (\$)	Small Entity Code	Small Entity Fee (\$)	Fee Description	Fee Paid
101	690	201	345	Utility filing fee	
106	310	206	155	Design filing fee	
107	480	207	240	Plant filing fee	
108	690	208	345	Reissue filing fee	
114	150	214	75	Provisional filing fee	

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES

Total Claims	Extra Claims	Fee from below	Fee Paid
Independent Claims	** =	X	
Multiple Dependent Claims	** =	X	

Multiple Dependent Claims

*or number previously paid, if greater; For Reissues, see below

Large Entity Small Entity

Large Entity Code	Large Entity Fee (\$)	Small Entity Code	Small Entity Fee (\$)	Fee Description
103	18	203	9	Claims in excess of 20
102	78	202	39	Independent claims in excess of 3
104	270	204	135	Multiple Dependent claim
109	78	209	39	**Reissue independent claims over original patent
110	18	210	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

FEE CALCULATION (continued)

3. ADDITIONAL FEE

Large Entity Code	Large Entity Fee (\$)	Small Entity Code	Small Entity Fee (\$)	Fee Description	Fee Paid
105	130	205	65	Surcharge - late filing fee or oath	
127	50	227	25	Surcharge - late provisional filing fee or cover sheet	
139	130	139	130	Non-English specification	
147	2,520	147	2,520	For filing a request for reexamination	
112	920	112	920	Requesting publication of SIR prior to Examiner action	
113	1,840	113	1,840	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for response within first month	
116	380	216	190	Extension for response within second month	
117	870	217	435	Extension for response within third month	
118	1,360	218	680	Extension for response within fourth month	
128	1,850	228	925	Extension for response within fifth month	
119	300	219	150	Notice of Appeal	
120	300	220	150	Filing a brief in support of an appeal	
121	260	221	130	Request for oral hearing	
138	1,360	138	1,360	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive - unavoidably	
141	1,210	241	605	Petition to revive - unintentionally	
142	1,210	242	605	Utility issue fee (or reissue)	
143	430	243	215	Design issue fee	
144	580	244	290	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
123	50	123	50	Petitions related to provisional applications	
126	240	126	240	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (times number of properties)	
146	760	246	380	Filing a submission after final rejection (37 CFR 1.129(a))	
149	760	249	380	For each additional invention to be examined (37 CFR 1.129(b))	
Other fee (specify) _____					
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* Reduced by Basic Filing Fee Paid

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SUBMITTED BY

Typed or Printed Name	Thomas M. Coester, Reg. No. 39,637			Complete (if applicable)
Signature	<i>Thomas Coester</i>	Date	05-09-00	Reg. Number
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